

REMARKS

In response to the Office Action dated May 6, 2004, and pursuant to the Office Action dated December 10, 2002, Applicant submits this amendment and the following remarks in order to comply with the proper claim amendment format.

Allowed Claims

Applicant thanks the Examiner for indicating claims 1-13 and claims 16-18 are in condition for allowance.

Rejection under 35 U.S.C. § 102

Claim 20 is rejected under 35 U.S.C. § 102(b) as being anticipated by Nelson, (U.S. Patent No. 3,696,878).

Anticipation under 35 U.S.C. § 102 “requires that each and every element of the claimed invention be disclosed in the prior reference.” *Akzo v. U.S. Int’l Trade Comm’n*, 1 U.S.P.Q.2d 1241 (Fed. Cir. 1986). Nelson does not disclose each and every element of the compactor of claim 20.

Claim 20 is directed to a compactor having at least two modular compaction units, a compaction belt and support means for the belt on the compaction units and a power source. The support means defines a planar lower run of the belt and forms a compaction surface.

Nelson teaches a traction vehicle 10 with a rear traction unit 11. The traction units comprise endless belts 57 trained about the tires 25 on each set of front and rear wheels. (column 3, lines 58-62). The belts may be fabric and rubber belts or may be made from various other materials, which have good tractive effort with the ground and give a long life. (column 3, lines 62-64) Nelson does not disclose a compaction belt or a support means defining a planar lower run of the belt forming a compaction surface. Because claim 20 contains at least one element that is not disclosed by Nelson, claim 20 is *prima facie* not anticipated by Nelson. Therefore, claim 20 is patentable over Nelson.

Rejections under 35 U.S.C. § 103

Claims 23 and 24 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Nelson as applied above, and further in view of Moorhead (U.S. Patent No. 3,832,079). Claim 33 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Nelson as applied above, and further in view of Abd. El Halim (U.S. Patent No. 4,737,050).

With respect to the §103 rejections, according to MPEP 2141.01(a), “in order to rely on a reference as a basis for rejection of an applicant’s invention, the reference must either be in the field of applicant’s endeavor or, if not, then be reasonably pertinent to the particular problem with which the inventor was concerned.” *In re Oetiker*, 977 F.2d 1443, 1446, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

In the present application, the problem with which the inventor is concerned is the compaction of asphalt cement. Nelson in no way addresses compaction issues, but rather discloses a simple and improved form of vehicle, adapted for traveling over rough terrain. (column 7, lines 20-23) Nelson teaches that traction is attained by continuous flexible traction devices trained about low-pressure rubber tires. (column 1, lines 19-23) The rough terrain vehicle of Nelson is non-analogous to the asphalt compaction apparatus of the present invention.

Further, according to MPEP 2143.02, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, or if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is not suggestion or modification to make the proposed modification and the references are not sufficient to render the claims *prima facie* obvious.

With respect to claims 23 and 24, modifying Nelson to create a compaction device changes the principle of operation and renders Nelson unsatisfactory for its intended purpose, namely, improved travel over rough terrain. Moorhead does not correct the deficiency of Nelson. The drum configuration of Moorhead does not change that Nelson is not a compaction device, but an improved rough terrain vehicle.

Further, with respect to claim 33, Halim does not correct the deficiency of Nelson. Incorporating the belt of Halim does not change that Nelson is not a compaction device, and modifying Nelson to create the compaction device of the present invention would render Nelson unsatisfactory for its intended purpose.

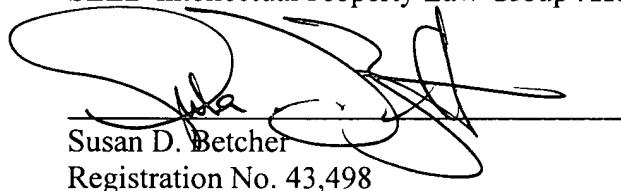
Claims 23, 24 and 33 are therefore patentable under 35 U.S.C. §103(a) over Nelson in view of Moorhead and Nelson in view of Hamlin.

Applicant respectfully submits that all claims remaining in the application are now clearly allowable. Favorable consideration and a Notice of Allowance are earnestly solicited. If questions remain, please contact the undersigned at the telephone number listed below. The Commissioner is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Respectfully submitted,

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